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| 10/643,288 | 08/20/2003 | Francis Luca Conte | 23FLC31 | 4031 |
| 20185 | 7590 | 07/27/2005 | EXAMINER | |
| FRANCIS L CONTE 6 PURITAN AVENUE SWAMPSCOTT, MA 01907 | | | ROWAN, KURT C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3643 | |

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/643,288
Filing Date: August 20, 2003
Appellant(s): CONTE, FRANCIS LUCA

Frances Conte
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 5, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-4 and 17 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 5-9 and 18-20 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 10-16 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|---------|---------|
| 1,009,531 | Kopp | 11/1911 |
| 2,642,057 | Watkins | 6/1953 |
| 2,505,591 | Stone | 4/1950 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 17 are rejected under 35 U.S.C. 103 over Kopp. This rejection is set forth in a prior Office Action, mailed on 12/17/2004.

Claims 5-9 and 18-20 are rejected under 35 U.S.C. 103 over Kopp in view of Watkins. This rejection is set forth in a prior Office Action, mailed on 12/17/2004.

Claims 10-16 are rejected under 35 U.S.C. 103 as being obvious over Kopp in view of Watkins and Stone. This rejection is set forth in a prior Office Action, mailed on 12/17/2004.

(11) Response to Argument

The examiner drops the rejection of claim 17 under 35 USC 112. In regard to claim 1, applicant argues that the examiner has not met the burden in applying specific evidence. Applicant asserts that the construction and operation of the gun of Kopp is quite different than that of the present invention. However, the only difference between Kopp and the present invention as recited in claim 1 is that Kopp shows one rubber band and the present invention recites two. The application of *In re Garza* would

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provide Kopp with two rubber bands. How would they be used. The two rubber bands would be looped together with one end connected to means 4 and the other end would be connected to fixed piece 7 by a knot or other suitable connection. The motivation of using two rubber bands rather than one is merely that at some point in use the rubber band 5 is going to break, and when it does the user, may not have a rubber band of the same length as the original. The user might have two shorter rubber bands that add together in length to that of the original rubber band. So to keep the device operational the user would have the choice of waiting to get another rubber band of the same length as the original or employ two shorter rubber bands. Hence one skilled in the art would have found it obvious to employ two or a plurality of rubber bands instead of one. A user would have contemplated both a lengthwise connection between the rubber bands and also a side by side connection of the rubber bands along one stock. Other configurations are also possible.

Applicant questions the multiplied effect of the rubber bands joined together at a knot therebetween. The multiplied effect is that combination when connected in a U-shaped mounting with two ends mounted to the front of the rubber band gun and the middle portion mounted to the fixed piece 7 would have a wider area of rubber being sent at the insect which is a multiplied effect.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As to Kopp not employ an annular band, the knot 6 of Kopp at one end of the band 5 can be considered annular since a loop is formed. Applicant states that it does not appear possible that an annular rubber band could even function in the toy gun of Kopp but has submitted no evidence in the form of a declaration or other evidence to substantiate this point. The releasing means of Kopp is the end 13 of the straight portion 12 of the trigger moving upwardly to move the knob 6 of the band 5.

In response to applicant's argument that there is no suggestion to combine the references Kopp, Watkins, and Stone, in claims 5-9, 18-20, and 10-16, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art. For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Kurt Rowan
Primary Examiner
Art Unit 3643

KR
July 23, 2005

Conferees

JK

DA

FRANCIS L CONTE
6 PURITAN AVENUE
SWAMPSCOTT, MA 01907